UNITED STATES PATENT AND TRADEMARK OFFICE

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09/888,547	06/26/2001	Kazuhiro Sugawara	03500.015492.	9436

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EXAMINER
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ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _02 October 2008_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _44-49,62,63,68 and 69_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _44-49,62,63,68 and 69_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some *   c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

Detailed Action

1.   This Office Action is responsive to the Amendment filed 10/02/2008. Claims 44,

49, 62, 63, 68 and 69 have been amended. Claims 44-49, 62, 63, 68 and 69 remain

pending for examination.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
> are such that the subject matter as a whole would have been obvious at the time the invention was made to
> a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

3.   **Claims 44, 49, 62-63 and 68-69 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Iwazaki (US 6,687,742), in view of Wakasugi (US 6,823,367).

4.   As to claim 44, **Iwazaki** teaches an image communicating apparatus, comprising:

a transmitting unit, adapted to send email data accompanied by an image file

(Internet facsimiles 3 and 8 have both units functioning in transmission/reception emails

with attached image) **(Iwazaki, col. 4, line 56 – col. 5, line 4)**;

a receiving unit, adapted to receive email data *(Internet facsimiles 3 and 8 have*

both units functioning in transmission/reception emails *with attached image)* **(Iwazaki,**

col. 4, line 56 – col. 5, line 4);

a requesting unit, adapted to add, selectively, information for requesting a

message disposition notification "MDN" to the email data to be sent to a receiver by said

transmitting unit *(a request for an MDN message is made by adding a "Disposition*

Notification-To:" field to the header of an email to be transmitted to a receiver) **(Iwazaki,**

Fig. 4 and col. 6, lines 39-48);

a communication managing unit, adapted to manage transmission management

information of the sent email data *(the processing result from the MDN response*

message is recorded in transmission history information) **(Iwazaki, col. 7, lines 61-64)**;

a determining unit, adapted to determine whether email data received by the

receiving unit is the message disposition notification to the email data that the

transmitting unit has sent *(in step 4 of Fig. 3, the sender determines if a response*

message in the form of MDN has been sent from the receiver) **(Iwazaki, col. 7, lines**

51-67);

an analyzing unit, adapted to analyze how the sent email data to which the

information for requesting the message disposition notification was added is processed

by the receiver in a case where the determining unit has determined that the email

received by the receiving unit is the message disposition notification, by analyzing the

message disposition notification included in the email data received by the receiving unit

*(as illustrated in Fig. 6 **"Disposition: automatic-action/MDN-send-automatically;***

dispatched" and as illustrated in Fig. 11 "Disposition: automatic-action/MDN-send-automatically; processed/warning" described in the MDN message, which is checked/analyzed to indicate the reception process of the sent email data received by the receiving unit and in this case, the sent email data was properly received and dispatched and/or processed) **(Iwazaki, Figs. 6 and 11 and col. 10, lines 17-26 and col. 12, lines 12-23 and 57-67)** and capable of representing plural kinds of processed results as processed results for the sent email by the receiver *(for example, "displayed", "dispatched", "processed", "printing", "deletion", "denied", failed", etc., are capable of representing plurality of processed results in a MDN message)* **(Iwazaki, col. 12, lines 12-23)**.

a judgment unit, adapted to judge whether or not a result of the transmission of the sent email data to which the information for requesting the message disposition notification was added was successful, based on an analysis result by the analyzing unit *(as illustrated in Fig. 6 "Disposition: automatic-action/MDN-send-automatically; dispatched" and as illustrated in Fig. 11 "Disposition: automatic-action/MDN-send-automatically; processed/warning" described in the MDN message, which is checked/analyzed to indicate the reception process of the sent email data received by the receiving unit and in this case, the sent email data was properly received and dispatched and/or processed)* **(Iwazaki, Figs. 6 and 11 and col. 10, lines 17-26 and col. 12, lines 12-23 and 57-67)**, wherein the judgment unit classifies three or more processed results that the message disposition notification is capable of representing into two kinds of judged results concerning whether or not the result of the transmission

of the sent email was successful *(as defined by RFC 2298, and described in the MDN message are the result of processing the received message, such as "displayed", "dispatched", "processed", "printing", "deletion", "denied", failed", etc., wherein for example, "displayed", "dispatched", "processed", "printing" being classified into "successful" result and "denied", "failed" as "unsuccessful" result)* **(Iwazaki, col. 12, lines 12-23)**; and

wherein the communication managing unit updates the transmission management information by information showing whether or not the transmission of the sent email data succeeded, on the basis of a judged result provided by the judgment unit *(the sender records the processing result in the returned MDN message in the transmission history information)* **(Iwazaki, col. 7, lines 61-64 and col. 13, lines 45-55)**.

However, **Iwazaki** does not explicitly teach a notifying unit notifies the user of said image communicating apparatus whether or not the transmission of the sent email data succeeded, on the basis of the updated transmission management information, so that the user of said image communicating apparatus can confirm whether or not the transmission of the sent email data succeeded, without reading the message disposition information.

In an analogous art, **Wakasugi** discloses a system and method of allowing user to browse the history of transmission on data terminal, wherein the network facsimile device NFA has an ability to output the communication management information in the form of a communication management report which is created and outputted based on

the recorded contents of the communication management table 4a shown in Fig. 8 *(the*

NFA detects the delivery confirmation mail sent from the NFB at step 104 and executes

the reception process of the delivery confirmation mail at step 105 and as illustrated in

*Fig. 5 "**Disposition manual-action/MDN-send-Manually; displayed**" indicates that the*

sent email data was properly received and displayed, the NFA changes "—" to "OK" in

the result field of the communication management information recorded in the

communication management table 4a) **(Wakasugi, Figs. 8-9, 12 and 17, col. 9, lines**

12-36 and col. 9, line 65 – col. 10, line 3).

Therefore, it would have been obvious to one having ordinary skill in the Data

Processing Art at the time the invention was made to incorporate the feature of notifying

the user of said image communicating apparatus so that the user can confirm whether

or not the transmission of the sent email data succeeded, without reading the message

disposition information, as disclosed by **Wakasugi**, into the teaching of **Iwazaki**, since

both references are directed to electronic message processing systems, hence, would

be considered to be analogous based on their related fields of endeavor.

One would be motivated to do so to allow the communications system to inform

the sending user the status of the delivery of the message.

5.   Claim 49 contains similar limitations as claim 44; therefore, it is rejected under

the same rationale.

6.   Claims 62-63 and 68-69 are corresponding method and computer readable storage medium claims of apparatus claims 44 and 49; therefore, they are rejected under the same rationale.

7.   **Claims 45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwazaki, in view of Wakasugi, and further in view of Miyamoto et al. (US 6,327,046), hereinafter "Miyamoto".**

8.   As to claim 45, **Iwazaki-Wakasugi** teaches the apparatus of claim 44, but does not explicitly teach a selecting unit, adapted to select ON/OFF of an execution of said requesting unit, wherein said communication managing unit manages ON/OFF of the request of the message disposition notification as transmission information for every sent email.

In an analogous art, **Miyamoto** teaches an electronic mail processing apparatus and method <u>comprising a selecting part for selecting whether a request for reply to an electronic mail to be transmitted is to be made or not by marking the check box 19 in Fig. 5 to turn ON a reply email request</u> **(Miyamoto, Fig. 5 and col. 6, lines 16-32)**. **Miyamoto** also teaches that if a reply from the receiver of the email has been sent, the task finish flag 11-4-5 in the Todo task list storage section 11-4 of the RAM 11 is set to be *"1" (i.e., update the transmission information on the basis of whether or not said requesting unit requests the reply email responsive to the sent email)* **(Miyamoto, col. 6, line 62 – col. 7, line 18)**.

Therefore, it would have been obvious to one having ordinary skill in the Data Processing Art at the time the invention was made to incorporate the feature of a selecting unit, adapted to select and manage ON/OFF of the request of the message disposition notification as transmission information for every sent email, as disclosed by **Miyamoto**, into the teachings of **Iwazaki-Wakasugi**, since references are directed to electronic message processing systems, hence, would be considered to be analogous based on their related fields of endeavor.

One would be motivated to do so to allow the sender to select whether a request for reply to an email from the receiver to be made or not at the time of transmitting the email and to specify a due date of reply and to retransmit the same email automatically when no reply has been received within a predetermined period of time.

9.   As to claim 46, **Iwazaki-Wakasugi-Miyamoto** teaches the apparatus of claim 44, wherein said communication unit updates the transmission information to first information showing that the message disposition notification responsive to said sent email data has been received *(i.e., the task finish flag 11-4-5 is set to "1", the item is displayed as a processed task with a check mark)* **(Miyamoto, Figs. 7-8, col. 7, lines 6-18 and col. 8, lines 19-32)**. The same motivations regarding the obviousness of claim 45 would be applied equally well to claim 46.

10.   As to claim 47, **Iwazaki-Wakasugi-Miyamoto** teaches the apparatus of claim 44, wherein said communication unit updates the transmission information to second

information showing that the message disposition notification responsive to the sent

email data was not received within a predetermined period of time *(i.e., the task finish*

flag is set to "0", the item is displayed as an unprocessed task) **(Miyamoto, Figs. 7-8**

and col. 7, lines 6-21). The same motivations regarding the obviousness of claim 45

would be applied equally well to claim 47.

11.   As to claim 48, **Iwazaki-Wakasugi-Miyamoto** teaches the apparatus of claim 44,

wherein said notifying unit visually outputs the transmission management information,

which is managed by said communication managing unit **(Wakasugi, Figs. 8-9, 12 and**

17, col. 9, lines 12-36 and col. 9, line 65 – col. 10, line 3).

Response to Arguments

12.   In the Remarks, Applicants argued in substance that

(**A**)   *"Nothing in either **Iwazaki** or **Wakasugi** teaches or suggests the analyzing*

unit or the judgment unit of claim 44," as recited in pages 19 of the Remarks.

As to point (**A**), Examiner respectfully disagrees noting that **Iwazaki** teaches

when a receiver performs a process such as printing the attached image, describes the

processing result and the capability of the receiver in an MDN message, as illustrated in

Fig. 6, "**Disposition: automatic-action/MDN-send-automatically; dispatched**" and as

illustrated in Fig. 11 "**Disposition: automatic-action/MDN-send-automatically; processed/warning**" and then transmits the MDN message back to the sender. The sender records the processing results in the received MDN message in the transmission record information and then terminates the transmission job **(Iwazaki, Figs. 6 and 11 and col. 10, lines 17-26)**. As apparent from the above, one of ordinary skill in the art would have duly recognized that in order for the **Iwazaki's** mechanism to identify and record "the processing results" in the received MDN message in the transmission record information, the processed results, as defined by RFC 2298 and described in the MDN message, such as "displayed", "dispatched", "processed", "printing", "deletion", "denied", "failed", etc., are identified from the MDN message, analyzed/judged to indicate the reception process of the sent email data received by the receiving unit and recorded in the transmission record information by the sender, wherein for example, "displayed", "dispatched", "processed", "printing" being classified into "successful" result and "denied", "failed" as "unsuccessful" result **(Iwazaki, Figs. 6 and 11 and col. 10, lines 17-26 and col. 12, lines 12-23 and 57-67)**.

In this case, Examiner respectfully submits that in view of the Supreme Court's recent opinion in *KSR Int'l Co. v. Teleflex Inc.*, "What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under U.S.C 103." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be "more than the predictable use of prior art elements according to their established functions." *Id.* at 1740. In *KSR*, the Supreme Court reaffirmed that "[w]hen a patent 'simply arranges old elements with each performing the same function

it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR,* 127 S. Ct. 1740 (quoting *Sakraida v. Ag Pro, Inc.,* 425 U.S. 273, 282 (1976)). Moreover, "[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product ... of ordinary skill and common sense." *KSR,* 127 S. Ct. at 1742.

This reasoning is applicable here. Clearly, **Wakasugi** teaches as illustrated in Fig. 5, wherein the status of the message disposition notification "**Disposition manual-action/MDN-send-Manually; displayed**" is obviously to be checked/analyzed to indicate that the sent email data was properly received and displayed, and the network facsimile device NFA changes "—" to "OK" in the result field of the communication management information recorded in the communication management table 4a **(Wakasugi, Fig. 5 and col. 9, lines 45-60)**.

Also, in the networking art, there are a finite number of identified, predictable solutions (such as the processed results of "displayed", "dispatched", "processed", "deleted", "denied" and "failed") available to a person of ordinary skill, as set forth in the **RFC 2298**. Furthermore, the message disposition notification MDN is notoriously well known in the art, as evidenced by **Iwazaki, Wakasugi** and **RFC 2298**, thus, Examiner respectfully submits that it would have been obvious to one ordinary skill in the art to combine the teachings of Iwazaki, Wakasugi and RFC 2298 to teach or suggest *"the analyzing unit or the judgment unit of claim 44,"* as recited in pages 19 of the Remarks

Conclusion

13.   Applicant's arguments as well as request for reconsideration filed on 10/02/2008

have been fully considered but they are not deemed to be persuasive.

14.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

15.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (571) 272-3886.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (571) 272-3880. The fax phone number for the organization is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Quang N. Nguyen/
Examiner, Art Unit 2441
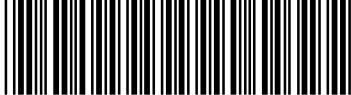
Application Number	Application/Control No.	Applicant(s)/Patent under Reexamination
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	Examiner	**Art Unit**
	QUANG N. NGUYEN	2441